

REMARKS

Upon entry of the present amendment, claims 1-2, 6-11 and 16-17 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the specification and claims do not incorporate new matter into the application as originally filed. In this respect, claim 2 and the specification at page 4 have been amended to clarify that the "hide" is a "leather" hide, such as a leather animal hide.

Regarding the amendment to claim 1, this simply corrects a typographical error. Regarding the amendment to claim 8, the same simply insures that the claim depends solely from non-cancelled claims.

Regarding the cancellation of claims 12-15, these claims have been cancelled based upon the Examiner's issuance of a Restriction Requirement, wherein these claims were withdrawn from consideration in the present case. Applicants reserve the right to file a Divisional Application on the cancelled withdrawn claims.

***Claim Rejections Under 35 USC § 112***

Claims 1-2, 6-11 and 16-17 have been rejected under 35 USC § 112, second paragraph. Reconsideration and withdrawal of this rejection is requested based upon the following considerations.

First, claim 1 has been amended to remove the typographical error occurring at line 2 thereof. Secondly, claim 2 has been amended to change the word "hide" to "leather" based upon description in the specification at page 4. As noted above, the word "hide" was originally meant to refer to a "leather" hide, such as an animal's "leather" hide.

Regarding claim 10, the Applicants do not understand the Examiner's comments, since claim 10, nor any other claim pending, appears to have an article "a" that should be placed in upper case form --A--.

Accordingly, withdrawal of the outstanding rejection under 35 USC § 112, second paragraph is required.

***Claim Rejections Under 35 USC § 102/103***

Claims 1-2, 6-8 and 16-17 have been rejected under 35 USC § 102(b) as being anticipated by the English abstract of JP 4-319433. The same claims have also been rejected under 35 USC § 103(a) over the same English abstract of JP 4-319433. Reconsideration and withdrawal of each of these rejections is respectfully requested based upon the following considerations.

JP 4-319433 discloses a laminate such as the vibration-controlling steel plate comprising a plated steel substrate layer, foaming resin intermediate layer and thermosetting resin paint skin

layer. As seen from the drawing of the prior art, the foaming resin intermediate layer is adhered to the plated steel substrate layer via an adhesive layer. Therefore, the prior art actually discloses a four-layered laminate which further comprises an adhesive layer between the plated steel substrate layer and the foaming resin intermediate layer in addition to the three layers above. The fact that the laminate disclosed in the prior art comprises the four-layered laminate in which an adhesive layer exists between the plated steel substrate layer and the foaming resin intermediate layer is supported in the English abstract. The English abstract describes:

*"Pref. The vibration-controlling steel plate is prepd. by coating the surface of 0.3-1.2 mm-thick steel or plated steel plate with a 1-10 micron-thick adhesive (e.g., .....), dry coating the adhesive surface with 60-700 micron dry thick-foaming resin sheet in the form of molten resin, powder, paint or film and then with up to 100 micron-thick thermosetting resin and heating the laminated steel plate at a temp. = up to the decomposition temp. of foaming agent. The press-worked steel sheet is heated to foam the foaming layer."*

Because the laminate (vibration-controlling steel plate) is used in practice in the form of the laminate, the foaming resin intermediate layer needs to be foamed and to be adhered to the steel plate. Therefore, the foaming resin intermediate layer is adhered to the steel plate via an adhesive layer.

To avoid confusion on the USPTO Examiner's part, the expression of the layers constituting the laminate between the prior art and the present invention are noted as follows.

The adhesive layer between the plated steel substrate layer and the foaming resin intermediate layer corresponds to (C) an adhesive that does not become capable of release even when receiving energy (hereinafter referred to as "the layer (C)") in the present laminate. The foaming resin intermediate layer and the plated steel substrate layer correspond respectively to (B) an adhesive which comprises a foaming agent and at least one selected from a thermosetting resin and photosetting resin (hereinafter referred to as "the layer (B)") and (A) the substrate layer (hereinafter referred to as "the layer (A)") in the present laminate.

In the present laminate, the adhesive layer between the layer (A) and the layer (B) doesn't exist. In other words, the layer (B) is directly laminated on the layer (A). The present laminate excludes the laminate sequence of the layer (A)/the layer (C)/the layer (B), because the present claim 1 restricts the layer (A), the layer (B) and the layer (C) are laminated sequentially.

Before being foamed by heating or irradiating the laminate, the layer (B) is adhered to layer (A). After being foamed, the layer (B) is easily released from the layer (A). For easy-release,

the layer (C) should not exist between the layer (A) and the layer (B).

As mentioned above, the foaming resin intermediate layer in the prior art needs to be foamed and to be adhered to the steel plate and the layer is adhered to the steel plate via an adhesive layer. On that point, the construction of the present laminate and that of the prior art is different and the difference results from the difference of the functions for the effects. It is not obvious from the prior art to change the sequence of the laminate because of the difference of the function of the layers constituting the laminate.

Upon viewing the Examples in the present specification, the effect of the present invention becomes evident. In Example 1, the sequence of the laminate obtained is (A-1)/(B-1)/(C-4)/(A-2), in which both of (A-1) and (A-2) correspond to the layer (A), (B-1) corresponds to the layer (B) and (C-4) corresponds to the layer (C). As (B-1) is directly laminated on the surface of (A-1) and (C-4) is laminated on the surface of (B-1), the sequence ((A-1)/(B-1)/(C-4)) constitutes the present laminate. As (A-2) is directly laminated on the surface of (C-4), this sequence ((A-2)/(C-4)/(B-1)) constitutes the prior art. After UV irradiation, (A-1) was easily released with little adhesive layer adhering thereto as evaluated "O" in Table-1 (see page 32), whereas (A-2) could not be

released from the laminate easily and the adhesive remained adhered to (A-2) as evaluated by "X" in Table-1 (see page 32).

***Explanation of the Drawings in JP 4-319433***

For completeness, it is noted that the Japanese written in the drawing in JP 4-319433 is translated to English as follows:

- a ← Upper Skin Layer
- b ← Foaming Resin Layer
- c ← Adhesive Layer
- d ← Steel Plate

Accordingly, based upon the above considerations, it is clear that the cited JP 4-319433 reference is incapable of either anticipating or rendering obvious Applicants' claimed invention. In this respect, the cited JP 4-319433 reference does not teach each of the elements recited in the present claims, and provides no motivation to those skilled in the art to arrive at the instant invention.

**CONCLUSION**

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that pending claims 1-2, 6-11 and 16-17 are allowable at present.

Appl. No. 09/889,791

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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